

### **REMARKS**

This Amendment accompanies a Request for Continued Examination (RCE) in the above-captioned patent application, and is responsive to a Final Office Action in this case mailed on January 12, 2004.

In the Final Office Action, the Examiner rejected claims 1-9, 11 and 15-22 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,669,040 to Hisatake; and rejected claims 10 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Hisatake "in lieu of obviousness" (Office Action at page 13).

At the outset, Applicants note with appreciation, the courtesy extended by the Examiner and his supervisor, Mr. Ayaz Sheikh, in granting an interview with the undersigned on June 14, 2004 (the "Interview"). Applicants respectfully submit, however, that they do not subscribe to the Examiner's assertions set forth in the Interview Summary form PTOL-413 provided by the Examiner following the Interview.

Claims 1, 11, 18, 19, 21 and 22 have been amended to more appropriately claim the present invention and withdrawn claims 12 and 14 have been cancelled without prejudice or disclaimer thereof. Applicants have also added new claims 23-27, which depend respectively from claims 1, 11, 18, 19, 21 and 22, and claim additional aspects of Applicants' invention. In particular, each of claims 23-27 recites, in addition to the element recited in the respective independent claims, "said predetermined event includes an instruction input operation of a user." Support for new claims 23-27 may be found, for example, in the specification at page 4, lines 12-13 ("[t]he predetermined event may be an instruction input operation of a user ...").

Applicants respectfully traverse the Examiner's rejection of claims 1-9, 11 and 15-22 under 35 U.S.C. § 102(b) as being anticipated by Hisatake. In order to properly anticipate Applicants' claimed invention under 35 U.S.C. §102, each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. §2131 (8th ed., Aug. 2001), quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th ed., 2001), p. 2100-69.

Present claim 1, for example, is not anticipated by Hisatake because the reference fails to teach each and every element of the claim. In particular, Hisatake fails to disclose at least the claimed combination including "a storage section that stores the pause condition set by the setting section" and "a pause section that makes an execution of at least one of the plurality of jobs satisfying the pause condition pause independently of the remaining plurality of jobs in response to a predetermined event," as recited in amended claim 1.

In the Final Office Action, the Examiner alleged that block 102 of Figure 20 of Hisatake constitutes store means (Final Office Action at page 5). The Examiner further alleged that store means is discussed at column 13, lines 15-25, column 14, lines 35-60 and column 22, lines 28-35. Applicants respectfully submit, however, neither the cited portions of Hisatake nor the remainder of that reference disclose at least Applicants' storage section.

Fig. 20 merely shows a RAM 102, but does elaborate further as to what information is stored in RAM 102. Moreover, the cited portions at col. 13 suggest that an operator can “temporarily stop processing of a desired job ...[by selecting] the desired job out of the job list on the job listing section U11 and may press the STOP key U12b.” To the extent such temporarily stopping a job corresponds to a pause, such teachings fall short of disclosing a “storage section that stores a pause condition set by the setting section,” as recited in claim 1.

The cited disclosure at column 14 only discusses job number and job mode items identified in a job management table shown in Fig. 11, and at column 22, RAM 102 is identified without any further detail except as a “working memory of the MPU 101” (col. 22, lines 33-35). These portions of Hisatake, therefore, also fail to teach at least the claimed storage section.

During the Interview, the Examiner cited portions of Hisatake at columns 9-11 related to job amount information and processing of new jobs. Applicants note that Hisatake discloses a formula for calculating job amount information (col. 9, line 30; formula (1)) and a processing flow when a new job occurs in Fig. 5. When a new job (job A) occurs, Hisatake teaches comparing a job amount of job A with that of another job, job B. If the job amount of job A is equal to or larger than that of job B, job A is placed in a “wait state” (see “No” at S10 in Fig. 5, see also column 11, lines 49-52, “[i]f the job amount information A is equal to or greater than the job amount information B.”) These portions of Hisatake teach that the job amount information of one job verses another determines whether a job is placed in a wait state. The wait state is thus based upon the dependence of one job relative to another. In contrast, the claimed storage

section stores a pause condition, which when satisfied, causes a job to “pause independently of the remaining jobs.”

Further, the above-noted teachings in Hisatake of the inter-dependence of one job relative to another, also fail to disclose at least the claimed pause section, which “makes an execution of ... one of the plurality of jobs satisfying a pause condition [stored in the storage section] pause *independently* of the remaining plurality of jobs in response to a predetermined event.” Emphasis added.

Present independent claims 11, 18 and 19 each recites, among other things, a storage section and a pause section. Moreover, the pause section recited in each of these claims is configured to “pause independently of the remaining plurality of [document processing (claims 18 and 19)] jobs,” and is thus similar to amended claim 1 in this respect. Claims 11, 18 and 19 are therefore not anticipated by Hisatake at least for reasons discussed in regard to claim 1.

Present claims 21 and 22 are directed toward a job execution method, and each recites, among other things, a step of “making an execution of at least one of the plurality of jobs satisfying a predetermined pause [(second, claim 22)] condition *independently* of the remaining plurality of jobs in response to the predetermined event.” Present claims 21 and 22, while of different scope, are therefore also similar to claim 1 in this respect, and are deemed allowable for at least for reasons discussed above in regard to claim 1.

In light of the above-described deficiencies of Hisatake, Applicants respectfully submit that claims 1, 11, 18, 19, 21 and 22 are allowable over the applied reference. Moreover, claims 2-9 and 15-17 are allowable at least due to their dependence from

allowable claim 1, and claim 20 is allowable at least due to its dependence from allowable claim 18.

Applicants respectfully traverse the Examiner's rejection of 10 and 13 under § 103(a) as unpatentable over Hisatake "in lieu of obviousness [sic]." To the extent the Examiner's rejection is understood, Applicants note that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

In rejecting the claim 10, the Examiner alleges that "[i]t would have been obvious to one of ordinary skill ... to teach the additional condition...." The Examiner concludes, without citation to Hisatake or any other reference for that matter, that "[o]ne would be motivated to include such a function as to determine the importance of the job, and whether to perform any alterations on the job."

With respect to the rejection of claim 13, the Examiner concedes that Hisatake does not teach "wherein the keys are provided on a portion except for the display," but nevertheless concludes that such would have been obvious, again without citing any particular portion of Hisatake or other factual basis.

Applicants respectfully submit that such unsupported assertions are insufficient to maintain the rejection of claims 10 and 13 under 35 U.S.C. § 103. Hisatake is not

modifiable in the manner proposed by the Examiner, and claims 10 and 13 are allowable at least due to their dependence from allowable claim 1.

In regard to new claims 23-28, each recites, among other things, a predetermined event, which "includes an instruction input operation of a user."

Applicants respectfully submit that Hisatake is silent at least as to this element, and thus claims 23-28 are allowable at least due to their dependence from allowable claims 1, 11, 18, 19, 21 and 22, respectively.

In making the various references to the specification set forth herein, it is to be understood that Applicants are in no way intending to limit the scope of the claims to the exemplary embodiments shown in the drawings and described in the Specification. Rather, Applicants expressly affirm that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation and applicable case law.

In view of the above remarks, Applicants respectfully request reconsideration and withdrawal of the rejections under §§ 102 and 103(a) and allowance of this application.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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